

REMARKS

Upon entry of this Amendment, claims 3 and 7-10 will be pending, with claims 9 and 10 newly presented for examination. Applicant respectfully requests reconsideration of this application in view of the following remarks.

I. Regarding the Office Action

In the Office Action¹, the Examiner rejected claims 3 and 8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,584,054 to Tyneski et al. ("*Tyneski*"); rejected claim 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,233,464 to Chmaytelli (*Chmaytelli*)²; and rejected claim 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,122,486 to Tanaka et al. (*Tanaka*)³.

Applicant agrees with the Examiner's Interview Summary mailed February 22, 2005 regarding the finality of the previous Office Action. Applicant thanks the Examiner for conducting the interview and mailing a new non-final Office Action on February 22, 2005.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² U.S. Patent No. 6,233,464 to *Chmaytelli* does not qualify as prior art under 35 U.S.C. § 102(b), as *Chmaytelli*'s publishing date is May 15, 2001, which is after the present application's filing date of December 26, 2000. Applicant respectfully requests the Examiner to indicate a proper grounds of rejection, if any, in the subsequent Office Action.

³ U.S. Patent No. 6,122,486 to *Tanaka* does not qualify as prior art under 35 U.S.C. § 102(b), as *Tanaka*'s publishing date is September 19, 2000, within one year of the present application's filing date of December 26, 2000. Applicant respectfully requests the Examiner to indicate a proper grounds of rejection, if any, in the subsequent Office Action.

II. Regarding the amendment of the claims

Applicants have amended claim 7 to more appropriately define the scope of the invention. Support for this amendment may be found at, for example, page 13, lines 1-5 of Applicants' specification.

Applicants have added new independent claims 9 and 10. Support for these new claims may be found at, for example, Fig. 2, the accompanying portion of Applicants' specification, and original claim 2.

III. Regarding the rejection of claims 3 and 8 under 35 U.S.C. § 102(b) as anticipated by *Tyneski*

Applicants respectfully traverse the rejection of claims 3 and 8 under 35 U.S.C. § 102(b) as anticipated by *Tyneski*. In order to properly establish that *Tyneski* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Tyneski does not disclose each and every element of Applicants' claimed invention. Claim 3 calls for a combination including, for example, "means for enabling the processing means when the apparatus is switched on, and for enabling the transmission means when the receiving means thereafter receives a predetermined instruction." *Tyneski* fails to teach at least these elements.

The Examiner alleges that *Tyneski* teaches “enabling the transmitting means when the instruction receiving means thereafter receives a predetermined instruction (see col. 2, lines 50-55, in this once flap 104 of the handset is closed, the handset is used as a cordless phone and therefore is able to transmit signals)” (Office Action at p. 2). Applicant respectfully submits that the Examiner’s assertion is incorrect.

Rather, the cited portion of *Tyneski* recites,

[W]hile the handset 100 is operating as a personal organizer when the flap 104 is in the open position, signaling information can still be received with antenna 110, and the user can be alerted to an incoming call. The user may then close the flap 104 and use the handset as a cordless telephone to answer the call.

First, neither this portion nor any other portion of *Tyneski* explicitly teaches or suggests “means for enabling the processing means when the apparatus is switched on, and for enabling the transmitting means when the instruction receiving means thereafter receives a predetermined instruction,” as required by claim 3.

Second, assuming the Examiner is relying on principles of inherency by stating “once flap 104 is closed, the handset is used as a cordless phone and therefore is able to transmit signals,” this assertion is also incorrect. *Tyneski* teaches a phone communication system (*Tynseki*, col. 1, lines 43-44). As described in Applicant’s specification at p. 2, line 27 through p. 3, line 12,

When the conventional radio communication apparatus is switched on, the apparatus is set in the standby mode and radio waves are transmitted/received with the radio base station to register the position of the radio communication apparatus. Even after it, radio waves are periodically transmitted/received with the radio base station to establish synchronism with the radio base station and to stand by for transmission/reception of calls.

Thus, the switching on of the radio communication apparatus automatically starts transmission/reception of radio waves with the outside

(emphasis added). *Tynseki* thus does not teach or suggest, explicitly or inherently, that the transmitting means is enabled “when the instruction receiving means thereafter receives a predetermined instruction,” as recited by claim 3.

Accordingly, *Tyneski* cannot anticipate claim 3. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of claim 3 under 35 U.S.C. § 102(b) as being anticipated by *Tynseki*.

Independent claim 8 recites elements similar to elements of claim 3. Accordingly, at least for the reasons discussed above with respect to claim 3, *Tyneski* cannot anticipate claim 8. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 8 under 35 U.S.C. § 102(b) as being anticipated by *Tynseki*.

Also with respect to independent claim 8, the Examiner alleges, “the claim has the same limitations as that of claim 3, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 3” (Office Action at page 2). However, claim 8 differs from claim 3 at least by reciting “means for prohibiting the radio signal transmission by the transmitting means in accordance with the instruction, while keeping the processing means and the radio signal means operable.” The Examiner has not addressed these elements, nor does *Tyneski* teach or suggest at least these elements. For at least this additional reason, *Tyneski* cannot anticipate claim 8. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 8 under 35 U.S.C. § 102(b) as being anticipated by *Tynseki*.

IV. Regarding the rejection of claim 7 under 35 U.S.C. § 102(b) as anticipated by *Chmaytelli*

Applicants respectfully traverse the rejection of claim 7 under 35 U.S.C. § 102 as anticipated by *Chmaytelli*. As previously noted, *Chmaytelli* was not published more than one year before Applicant's filing date. The rejection of claim 7 under 35 U.S.C. § 102(b) is therefore improper. Moreover, in order to properly establish that a reference anticipates Applicants' claimed invention under any section of 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Chmaytelli does not disclose each and every element of Applicants' claimed invention. Claim 7, as amended, recites a combination including, for example, a "radio communication apparatus having a first mode in which the apparatus emits radio waves and a second mode in which the apparatus receives but does not emit radio waves" (emphasis added). *Chmaytelli* fails to teach or suggest at least these elements.

The Examiner asserts that *Chmaytelli* teaches "means for enabling the first mode [in which the apparatus emits radio waves] when the apparatus is switched on ... and for enabling the second mode [in which the apparatus does not emit radio waves] when the receiving means thereafter receives a predetermined instruction," citing col. 2, lines 10-16 of *Chmaytelli* (Office Action at p. 3). *Chmaytelli* recites in col. 2, lines 10-16 "power[ing] on the wireless telephone (206) in response to the signal from the action trigger ... [and] power[ing] off the wireless telephone in response to the signal from the

action trigger.” That is, *Chmaytelli* teaches powering off the wireless telephone entirely, but fails to teach or suggest at least “a second mode in which the apparatus receives but does not emit radio waves,” as recited by amended claim 7.

Accordingly, even if *Chmaytelli* were a proper reference under 35 U.S.C. § 102(b), *Chmaytelli* could not anticipate claim 7. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claim 7 under 35 U.S.C. § 102(b) as being anticipated by *Chmaytelli*.

V. Regarding the rejection of claim 7 under 35 U.S.C. § 102(b) as anticipated by *Tanaka*

Applicants respectfully traverse the rejection of claim 7 under 35 U.S.C. § 102(b) as anticipated by *Tanaka*. As previously noted, *Tanaka* was not published more than one year before Applicant’s filing date. The rejection of claim 7 under 35 U.S.C. § 102(b) is therefore improper. Moreover, in order to properly establish that a reference anticipates Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

As noted above, claim 7, as amended, recites a combination including, for example, a “radio communication apparatus having a first mode in which the apparatus emits radio waves and a second mode in which the apparatus receives but does not

emit radio waves” (emphasis added). *Tanaka* fails to teach or suggest at least these elements.

The Examiner alleges that “*Tanaka* teaches a radio communication apparatus ... having a first mode (... the releasing of transmission interruption) in which the apparatus emits radio waves and a second mode (...the transmission interruption) in which the apparatus does not emit radio waves,” citing col. 2, lines 33-40 (emphasis added, Office Action at p. 3). The Examiner further asserts that *Tanaka* teaches enabling a second mode “when the receiving means thereafter receives a predetermined instruction (transmission of the phone is interrupted once the phone has entered the restricted area)” (Office Action at p. 4). Even assuming the Examiner’s assertions are true, *Tanaka* fails to teach or suggest at least “a second mode in which the apparatus receives but does not emit radio waves,” as recited by amended claim 7.

Accordingly, even if *Tanaka* were a proper reference under 35 U.S.C. § 102(b), *Tanaka* could not anticipate claim 7. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claim 7 under 35 U.S.C. § 102(b) as being anticipated by *Tanaka*.

VI. Regarding new claims 9 and 10

New independent claims 9 and 10 recite elements similar to elements of original claim 2 (now canceled). The Examiner previously indicated that original claim 2 contained allowable subject matter (Office Action mailed November 21, 2003 at p. 4). Accordingly, Applicant respectfully submits that claims 9 and 10 are allowable.

VI. Conclusion

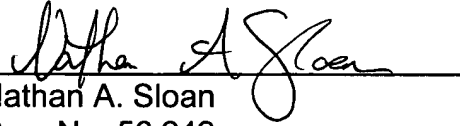
In view of the foregoing, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 22, 2005

By: 
Nathan A. Sloan
Reg. No. 56,249